

REMARKS**I. Status of the Claims**

Claims 1-14 are pending.

Claims 1 and 11 are amended.

Claims 1-7, 11 and 12 are under consideration, claims 8-10, 13-14 are withdrawn, but will be rejoined if composition claims are allowed.

II. Interview Summary

Applicant thanks Examiner Kim for helpful suggestions during the personal interview of January 9, 2008. Applicant's representatives Richard Lazarus and Alice Martin were present, Dr. Bernstein participated by telephone.

Dr. Bernstein summarized the invention, pointing out a novelty of the compositions of his invention is that the cis doxepin was present in greater percent relative to trans, resulting in analgesic effects comparable to more trans, but sedation effects were less, a desirable result and a non-obvious improvement over the art.

To support the argument that the invention is surprising and unexpected, Dr. Bernstein promised a Declaration under 37 CFR 1.132 presenting supplemental comparative data.

The rejection under 35 USC §112, 2nd par. was discussed. The meaning of the word "preponderance" in the application includes "majority", so a proposal to amend claims to "at least 51% cis" was made to overcome this rejection.

III. Claims are Definite

Claims 1-7, 11 and 12 were rejected under 35 U.S.C. § 112, second paragraph for use of the phrase "preponderance," rather than a specific numerical range.

As to indefiniteness, "preponderance" is a well-known term that means e.g. majority.

Dictionary.com unabridged (v.1.1)

Noun: the fact or quality of being preponderant; superiority in weight, power, numbers, etc.: The preponderance of votes is against the proposal.

Synonyms: predominance, majority, mass, bulk.

American Heritage Dictionary

Noun: Superiority in weight, force, importance, or influence.

WordNet

1. superiority in power or influence; "the preponderance of good over evil"; the preponderance of wealth and power"
2. A superiority in numbers or amount, "a preponderance of evidence against the defendant"
3. Exceeding in heaviness; having greater weight; "the least preponderance in either pan will unbalance the scale".

The claims simply mean that there is more cis isomer than trans isomer in the composition. This is not indefinite, merely because there is no claimed numeral range. However, to move claims toward allowance, preponderance is defined as "at least 51%."

IV. A Prima Facie Case of Obviousness is Not Established

Claims 1-7, 11-12 were rejected as obvious over Midha and applicant's admission. The examiner agrees that the Midha reference merely states that the cis-isomer is more active than the trans isomer. (Office Action, page 4) Yet, as noted, U.S. 5,502,047 states that prior art doxepin compositions (predominantly trans isomer) can be used to treat insomnia. These two references, taken together, actually teach away from the instant invention, because they suggest that cis-doxepin would have a greater sedative effect, not a lesser effect as recited in the claims. Accordingly, the rejection under 35 U.S.C. § 103 is respectfully traversed.

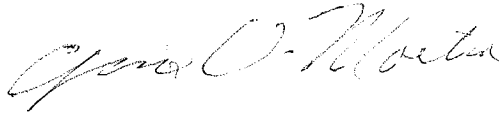
As promised during the interview of January 9, 2008, a Declaration under 37 CFR 1.132 is appended as Exhibit A to illustrate unexpected results with cis preponderant to trans.

V. Conclusion

As all grounds of rejection have been overcome, a Notice of Allowance is respectfully requested.

Applicants request allowance of the pending claims. No other fees are believed due at this time, however, please charge any deficiencies or credit any overpayments to deposit account number 12-0913 with reference to our attorney docket number (41959-102742).

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Alice O. Martin".

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